

## Remarks

Claims 1-3, 5-11 and 13-31 are now pending in this application. Applicants have amended claims 1-3, 5, 6, 9-11, 14, 16, 19-23, and 25 and cancelled claims 4 and 12 to clarify the present invention. Applicants respectfully request favorable reconsideration of this application.

The Examiner indicated that claim 12 recites allowable subject matter. Amended claim 1 recites the subject matter of claim 12. Applicant has made minor amendments to claim 1 to clarify that the injector is used to inject the coiled tubing and not the wireline. The coiled tubing must be pushed down or injected into the well. The wireline falls down by its own weight. Therefore, it is more technically accurate to delete the "wireline" as in claims 1 and 19. Accordingly, Applicants submit that claim 1 and claims 2, 3, 5-11, 13-18, and 28-31, which depend directly or indirectly from claim 1 are allowable.

The Examiner rejected claims 1-4, 7, 8, 19-26, 28, and 30 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 5,244,046 to Council. The Examiner rejected claim 10 under 35 U.S.C. § 103(a) as being unpatentable over Council in view of U.S. patent 6,843,321 to Carlsen. The Examiner rejected claim 27 under 35 U.S.C. § 103(a) as being unpatentable over Council in view of U.S. patent 6,386,290 to Headworth.

The rejection of claims 1-3, 7, 8, 10, 28, and 30 is moot since claim 1 now recites the subject matter of claim 12, which the Examiner indicated is allowable. Accordingly, Applicants

respectfully request withdrawal of the rejection of claims 1-3, 7, 8, 10, 28, and 30.

Council does not disclose the present invention as recited in claim 19, since, among other things, Council does not disclose a method that includes well assembly that includes feeding and retracting a coiled tubing and tool or toolstring through a lubricator pipe element of a lubricator with a moveable stripper/packer element. Additionally, Council also does not disclose connecting a moveable stripper/packer element to a well barrier module or retracting the lubricator pipe element through an injector module. In fact, it appears as if Council is not intended for subsea use and does not, among other features, disclose the structural elements and functionality with respect to lubricating into a subsea well recited in claim 19.

The present invention as recited in claim 19 includes forwarding the stripper/packer element together with the lubricator tube and the coiled tubing to an active position in which the coiled tubing is connected to the well barrier module. Then, the remaining portion of the lubricator can be retracted back through the injector to permit the injector to grasp the coiled tubing. Moreover, the lubricator package, including the pipe and the stripper/packer, may be taken to the surface together with the tool after the operation. On the other hand, Council discloses utilizing a stationary stripper 40 that swings away from an active position when a tool is forwarded. Then, the coiled tubing must be released from the tool and retracted in order to enable the stripper to swing back and once again forwarded and connected to the tool through the stripper. This is a complicated procedure which the present invention as recited in claim 19 avoid.

In view of the above, Council does not disclose all elements of the present invention as recited in claim 19 or claims and 20-26, which depend from claim 19. Since Council does not disclose all elements of the present invention as recited in claims 19-26, the present invention, as recited in claims 19-26, is not properly rejected under 35 U.S.C. § 102(b). For an anticipation rejection under 35 U.S.C. § 102(b) no difference may exist between the claimed invention and the reference disclosure. *See Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q. 841 (Fed. Cir. 1984).

Along these lines, anticipation requires the disclosure, in a cited reference, of each and every recitation, as set forth in the claims. *See Hodosh v. Block Drug Co.*, 229 U.S.P.Q. 182 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986).

The combination of Council and Headworth does not suggest the present invention as recited in claim 27, which depends from claim 19, since, among other things, Council does not suggest a method that includes well assembly that includes feeding and retracting a coiled tubing and tool or toolstring through a lubricator pipe element of a lubricator with a moveable stripper/packer element. Additionally, Council does not suggest a method that includes forwarding a lubricator including a lubricator pipe element and moveable stripper/packer element through an injector module. Headworth does not overcome these deficiencies of Council. The Examiner cites Headworth as suggesting a surface injector. Providing the structure suggested by Council with a surface injector would not suggest the present invention as

recited in claim 27.

In view of the above, the references relied upon in the office action, whether considered alone or in combination, do not disclose or suggest patentable features of the present invention. Therefore, the references relied upon in the office action, whether considered alone or in combination, do not anticipate the present invention or make the present invention obvious. Accordingly, Applicants request withdrawal of the rejections based upon the cited references.

In conclusion, Applicants respectfully request favorable reconsideration of this case and early issuance of the Notice of Allowance.

If an interview would advance the prosecution of this case, Applicants respectfully urge the Examiner to contact the undersigned at the telephone number listed below.

The undersigned authorizes the Commissioner to charge fee insufficiency and credit overpayment associated with this communication to Deposit Account No. 22-0261.

Respectfully submitted,

Date: 5/14/08

A handwritten signature in black ink, appearing to read "Eric J. Franklin", written over a horizontal line.

Eric J. Franklin, Reg. No. 37,134  
Attorney for Applicants  
Venable LLP  
575 7<sup>th</sup> Street, NW  
Washington, DC 20004  
Telephone: 202-344-4936